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Docket No. 1210/69014-A/GJG/BJA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Kiran K. Chada et al.

Serial No.: 10/630,423

Examiner: A. M. Wehbe

Filed : July 29, 2003

Art Unit: 1633

For : A METHOD OF IDENTIFYING ADIPOCYTE SPECIFIC GENES,  
THE GENES IDENTIFIED, AND THEIR USES

1185 Avenue of The Americas  
New York, New York 10036  
December 14, 2007

Commissioner for Patents  
P.O. BOX 1450  
Alexandria, VA 22313-1450

Sir:

COMMUNICATION IN RESPONSE TO NOVEMBER 16, 2007 NOTICE OF NON-  
COMPLIANT AMENDMENT AND CONFIRMATION OF EXAMINER TELEPHONE  
CONFERENCES

This is a response to Notice of Non-Compliant Amendment (37 C.F.R. §1.121) issued November 16, 2007 in connection with the above-identified application. A copy of the Notice is attached hereto as **Exhibit A**. A response to the November 16, 2007 Notice is due December 16, 2007. Accordingly, this Communication is being timely filed.

Applicants: Kiran K. Chada et al.  
Serial No.: 10/630,423  
Filed : July 29, 2003  
Page 2 of 4

In the November 16, 2007 Notice, the Examiner stated that in applicants did not file a complete list of claims, including cancelled claims, in their Communication filed September 26, 2007 in connection with the above-identified application.

In response applicants note that no claim amendments were made in the Communication filed September 26, 2007 and so no listing of claims was required. Applicants further note that a Preliminary Amendment was filed on July 29, 2003 amending the claims. However, no listing of claims was required to be filed because the rule change requiring such a listing did not become effective until July 30, 2003. In regard to this, applicants direct the Examiner's attention to the "Amendments Permitted Under Revised Amendment Practice and Treatment of Non-Compliant Amendments" notice published in Official Gazette dated September 23, 2003. A copy of the Official Gazette notice is attached hereto as **Exhibit B**. Accordingly, applicants note that their Communication filed September 26, 2007 was not "non-compliant".

#### Telephone Conferences with Examiner Gyan Chandra

On November 27, 2007 and November 28, 2007, Brian Amos, of the undersigned's office, contacted Examiner Gyan Chandra of the U.S. Patent and Trademark Office who issued the November 16, 2007 Notice to point out the error in issuing the Notice. Examiner Chandra agreed that the Communication filed September 26, 2007 was, in fact, compliant, and stated that he would "try" to have the Notice withdrawn. During a December 11, 2007 telephone conference initiated by Brian Amos of the undersigned's office Examiner Chandra stated that the case had now been transferred to Examiner Anne Maria Wehbe, but that he would contact Examiner Wehbe to apprise her of the situation as to why the Notice should be withdrawn.

Applicants: Kiran K. Chada et al.  
Serial No.: 10/630,423  
Filed : July 29, 2003  
Page 3 of 4

Telephone Conference with Examiner Anne Marie Wehbe

On December 13, 2007, Brian Amos, of the undersigned's office, contacted the Examiner Wehbe of the U.S. Patent and Trademark Office regarding withdrawal of the Notice. Examiner Wehbe agreed that the Notice should be withdrawn and that she would issue a letter withdrawing the Notice within the next week.

Accordingly, because the Notice was issued in error, and in light of the above detailed telephone conferences with Examiners Chandra and Wehbe, applicants hereby confirm their request to have the November 16, 2007 Notice of Non-Compliant Amendment withdrawn.

If a further telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Applicants: Kiran K. Chada et al.  
Serial No.: 10/630,423  
Filed : July 29, 2003  
Page 4 of 4

No fee is deemed necessary in connection with the filing of this Response. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450	
<u>Gary J. Gershik</u> Gary J. Gershik Reg. No. 39,992	<u>12/14/07</u> Date

Gary J. Gershik  
Gary J. Gershik  
Registration No. 39,992  
Attorney for Applicants  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
(212) 278-0400

# **EXHIBIT A**

# **Notice of Non-Compliant Amendment (37 CFR 1.121)**

Application No.

10/630,423

Examiner

Gyan Chandra

Applicant(s)

CHADA ET AL.

Art Unit

1646

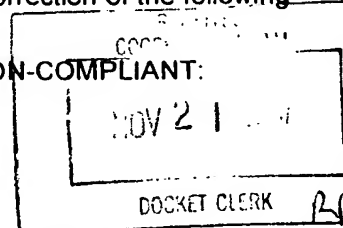
COPY

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 28 September 2007 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

## THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☐ E. Other: \_\_\_\_\_.
- ☒ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):  
See Continuation Sheet:



For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

## TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

**Extensions of time** are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

## **Failure to timely respond** to this notice will result in:

- Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or
- Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable

Telephone No.

Continuation Sheet (PTOL-324)  
PTOL-324 (01-06)

Notice of Non-Compliant Amendment (37 CFR 1.121)

Application No.

In response to the Restriction/Election mailed on 8/27/2007, applicants argue (page 2 of Response) that they have cancelled a number of claim in a Preliminary Amendment filed on 7/29/2003. They argue that only claims 1-15, 47, 102-103 and 116 are pending. Applicants have not filed a complete list of claims (including cancelled claims).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gyan Chandra whose telephone number is (571) 272-2922. The examiner can normally be reached on 9:00-5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol can be reached on (571) 272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gyan Chandra  
Art Unit 1646  
REM 4C19  
Tel: 571-272-2922  
Fax: 571-273-2922





UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,423	07/29/2003	Kiran K. Chada	69014-A/GJG	1805
7590 Gary J. Gershek Cooper & Dunham 1185 Avenue of the Americas New York, NY 10036		11/16/2007	EXAMINER CHANDRA, GYAN	
			ART UNIT 1646	PAPER NUMBER
			MAIL DATE 11/16/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## **EXHIBIT B**

**United States Patent and Trademark Office OG Notices: 23 September 2003****COPY****Amendments Permitted under the  
Revised Amendment Practice and  
Treatment of Non-Compliant Amendments****SUMMARY:**

Amendments submitted prior to July 30, 2003 in compliance with the previous version of 37 CFR 1.121 or the revised version promulgated in the Notice of Final Rule Making: Changes To Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. 38611 (June 30, 2003) (Revised Amendment Practice) will be accepted. Amendments filed on or after July 30, 2003, must be submitted in compliance with revised 37 CFR 1.121. The previously announced limited waivers permitting submission of amendments in the voluntary revised amendment format terminate on July 29, 2003. If a preliminary amendment or a reply under 37 CFR 1.111 filed on or after July 30, 2003 includes one or more non-compliant sections, applicant will be notified via a Notice of Non-Compliant Amendment that the non-compliant section(s) needs to be re-submitted in compliant form within a period set by the Office.

**BACKGROUND**

The United States Patent and Trademark Office (Office) previously announced a prototype program to evaluate the electronic image processing of patent applications using the image file wrapper system (IFW). See USPTO Announces Prototype of Image Processing, 1265 Off. Gaz. Pat. Office 87 (December 17, 2002). The notice included a limited waiver of 37 CFR 1.121 (available in applications being examined in the prototype program) which permitted amendments to be submitted in a voluntary revised amendment format. The limited waiver was later extended to all applications. See Amendments in a Revised Format Now Permitted, 1267 Off. Gaz. Pat. Office 106 (February 25, 2003). The Office revised its rules of practice to implement image file wrapper processing, including the Revised Amendment Practice, taking into account public comments, in the above-noted notice of final rule making, which is effective on July 30, 2003. Many members of the public have requested that the Office permit amendments to be submitted in compliance with the revised version of 37 CFR 1.121 before the effective date of July 30, 2003 in order to provide for a smoother transition to the new practice. This Notice adopts the suggestion.

**WAIVER OF 37 CFR 1.121 UNTIL JULY 29, 2003**

The provisions of 37 CFR 1.121(a), (b), (c) and (d) are hereby waived for amendments to the claims, specification, and drawings, filed before July 30, 2003 in all applications where the amendments comply with 37 CFR 1.121 effective on July 30, 2003. Note: The revised amendment rules (and this waiver) do not apply to 37 CFR 1.121(h) and (i) which indicate that amendments to reissue applications and reexamination proceedings are governed by 37 CFR 1.173 and 37 CFR 1.530(d)-(k), respectively.

**TREATMENT OF NON-COMPLIANT AMENDMENTS**

All amendments received by the Office on or after July 30, 2003 must be in compliance with the rules as required by the Revised Amendment Practice. This practice requires the submission of an amendment document that includes separate sections for amendments to the claims, drawings, specification and abstract, each beginning on a new sheet of paper. If an amendment is received as a preliminary amendment or as a bona fide reply under 37 CFR 1.111, that has compliant amendments to one or more separate section(s), but also

Applicants: Kirian K. Chada et al.

Serial No.: 10/630,423

Filed: July 29, 2003

**Exhibit B**

includes one, or more, separate section(s) with non-compliant amendments, the Office will mail a Notice of Non-Compliant Amendment requiring correction to the non-compliant section(s) within a time period set by the Office. When making corrections, applicant should just resubmit the needed corrected section(s), and correspondingly, should not resubmit the entire amendment document. For example, if the amendment included compliant amendments to the specification and claims, and non-compliant amendments to the drawings, a notice requiring resubmission of compliant amendments to the drawings would be sent. In reply to the notice, applicant should only submit a compliant amendment to the drawings, and not the previously compliant amendments to the specification and claims. If any additional, or further, amendments to the claims are desired, the changes must be made relative to the previous compliant amendment to the claims. The Office will consider both the previous compliant amendment to the claims, and the supplemental compliant amendment to the claims, after the Office receives the compliant amendment to the drawings.

An amendment submitted on or after July 30, 2003 as part of a reply after the close of prosecution (e.g., as a reply under 37 CFR 1.116) that is not compliant with the Revised Amendment Practice will not act to toll the outstanding time period. See 37 CFR 1.135(c). A notice (e.g., an advisory action) may be mailed by the Office specifying which section(s) of the amendment was not in compliance with the Revised Amendment Practice, but no new time period will be given to provide a compliant section.

FOR FURTHER INFORMATION CONTACT:

Questions concerning this notice may be submitted to Joseph Narcavage, Elizabeth Dougherty or Eugenia Jones by e-mail at [joseph.narcavage@uspto.gov](mailto:joseph.narcavage@uspto.gov) or by telephone at (703) 305-1622.

July 11, 2003

STEPHEN G. KUNIN  
Deputy Commissioner for  
Patent Examination Policy